UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,390	11/05/2001	Zhong-Min Wei	21829/111 (EBC-009)	4469

7590 01/30/2004

Michael L. Goldman
NIXON PEABODY LLP
Clinton Square
P.O. Box 31051
Rochester, NY 14603

EXAMINER	
PARA, ANNETTE H	

ART UNIT	PAPER NUMBER
1661	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/010,390	WEI ET AL.	
	Examiner	Art Unit	
	Annette H. Para	1661	

-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/10/3003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12,18-41 and 75-93* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *25-30,37-41,89 and 91* is/are allowed.

6)☒ Claim(s) *1-12,18-24,31-36,75-88,90,92 and 93* is/are rejected.

7)☒ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

The amendment of October 10, 2003 has been received and entered.

Double Patenting

Claims 1-5, 7 and claims 75-79, 86,92 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1- 2, 5, 8, 11, 13, 15, 17, 19, of US Patent No. 5, 776, 889. Applicants' arguments filed on October 10, 2003 have been fully considered but they are not persuasive. Applicants argue that Wei I do not teach the step of removing or harvesting a cutting from a plant or a treated plant. It would have been obvious to harvest a cutting off a floriculture crop. Applicants also argue that Wei I do not teach the step of "exposing the harvested cutting to conditions that ...would cause desiccation of the cutting or at least one flower thereon". This argument is not persuasive since it is not clear what "the conditions that would cause desiccations" are.

Claims 1-5, 7-12, remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No.09/835,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-5, 7-12, of the instant application contain the metes and bounds of claims 1-20 of copending application No. 09/835,684.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. Applicants arguments filed on October 10, 2003 have been fully considered but they are not persuasive. Applicants argue that Wei II do not teach the step of removing or harvesting a cutting from a plant or a treated plant. Wei II teach "treating a fruit or vegetable...to inhibit postharvest disease or desiccation" implying that the fruit or the vegetable is going to be removed from the plant after the treatment

Applicants also argue that suitable cuttings include "stems, leaves, flowers, or combinations thereof". Thus, a cutting is not necessarily a fruit or a vegetable. *Spinacia oleracea, beta vulgaris* are example of vegetable with stems, leaves, and flowers.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7, 18-22, 24, 75-79, 92, 88, 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wei et al.US Patent 5,776,889 in view of Laurie et al.

Wei et al teach the application of an elicitor protein to an ornamental plant. The plant is inherently desiccation resistant, absent evidence to the contrary. The hypersensitive response elicitor protein is derived from a pathogen selected from the group consisting of *Erwinia, Pseudomonas, Xanthomonas.*

Wei et al. do not teach using this method on a cutting removed from an ornamental plant.

Laurie et al. teach the cutting of flowers. It would have been obvious to apply the method of Laurie et al. to plant treated by the method of Wei et al. One would have been motivated to do so given the importance of the cut flower crops. There would have been a reasonable expectation of success, given the knowledge that this method works on a complete plant as taught by Wei et al. Thus, the invention as a whole was clearly *prima facie* obvious to one of ordinary skill in the art at the time the invention was made. Applicants argue that "the feature asserted to be inherent is immaterial, for purposes of obviousness..." See In re Verdegaal Brothers 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987).

"A patent claim to a process is anticipated by a prior art reference that discloses all of the limitations of that claim even though the reference does not expressly disclose the 'incentive concept' or desirable property discovered by the patentee. It suffices that the prior art process inherently possessed that property".

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C.103(c) and potential 35 U.S.C.102 (e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 8-12 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Wei et al. US Patent 5,776,889. Wei et al teach the application of an elicitor protein to an ornamental plant. The plant is inherently desiccation resistant, absent evidence to the contrary. It would have been obvious to harvest a cutting off a floriculture crop. The claims and Wei et al. state the same characteristics for the resultant plant. Thus, the claimed invention as a whole was at least *prima facie* obvious over, if not anticipated by, the prior art.

Claim Rejection - 35 U.S.C. 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12, 18-24, 31-36, 75-88, 90, 92, 93 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The step of "exposing the removed or harvested cutting to condition that, in the absence of said treating, would cause desiccation" is not described in the specification

Conclusion

Claims 25-30, 37-41 89, and 91 are allowed. Claims 1-12, 18-24, 31-36, 75-88, 90, 93 are rejected.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (571) 272-0982. The Examiner can normally be reached Monday through Thursday from 5:30 am to 4:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0994. The fax numbers for the group is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 872-9305.

A.H.P

Bruce Campell

BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600